



UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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AUG 12 2002

In re

:
: DECISION ON
: PETITION FOR REGRADE
: UNDER 37 CFR 10.7(c)
:

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 8, 17 and 18 of the morning session and questions 27 and 33 of the afternoon session of the Registration Examination held on October 17, 2001. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sessions of the Registration Examination. Petitioner scored 69.

On February 1, 2002, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

OPINION

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers. The directions to the morning and afternoon sessions state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the *Official Gazette*, or a notice in the *Federal Register*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications

for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms “USPTO” or “Office” are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner’s arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been granted no additional points on the Examination. No credit has been awarded for morning question 8, 17 or 18, and no credit has been awarded for afternoon question 27 or 33. Petitioner’s arguments for these questions are addressed individually below.

Morning question 8 reads as follows:

8. Joan comes to you wanting to know the status of the applications of her competitor Pete. During Joan’s previous relationship with Pete she believes she may have been a coinventor on one of the applications filed by Pete. Pete owns Applications A, B, C and D. Application B is a continuation of application A and a redacted copy of application A has been published under 35 U.S.C. § 122(b). Joan is listed as a coinventor on Application C. Pete has an issued patent that claims priority to Application D. Assume only the last six digits of the numerical identifier are available for Application D and Application D is abandoned. Which of the following is not true?

- (A) Joan may obtain status information for Application B that is a continuation of an application A since application A has been published under 35 U.S.C. § 122(b).
- (B) Joan may be provided status information for Application D that includes the filing date if the eight-digit numerical identifier is not available and the last six digits of the numerical identifier are available.
- (C) Joan may obtain status information for Application D since a U.S. patent includes a specific reference under 35 U.S.C. § 120 to Application D, an abandoned application. Joan may obtain a copy of that application-as- filed by submitting a written request including the fee set forth in 37 CFR 1.19(b)(1).
- (D) Joan may obtain status information as to Application C since a coinventor in a pending application may gain access to the application if his or her name appears

as an inventor in the application, even if she did not sign the § 1.63 oath or declaration.

- (E) Joan may obtain access to the entire Application A by submitting a written request, since, notwithstanding the fact that only a redacted copy of Application A has been published, a member of the public is entitled to see the entire application upon written request.

The model answer is selection (E).

8. ANSWER: Statement (E) is false and is not a correct statement. Since a redacted copy of the application was used for publication purposes, 37 CFR 1.14 (c)(2) provides that “(2) If a redacted copy of the application was used for the patent application publication, the copy of the specification, drawings, and papers may be limited to a redacted copy.” For (A) and (B), see 37 CFR 1.14(b)(2). For (C) see 37 CFR 1.14(b)(2) and (c)(1)(i). As to (D), a coinventor is entitled to access to the application independent of whether or not he or she signed the declaration. Note that as stated in 37 CFR 1.41(a)(2), if a declaration or oath is not filed, the inventorship is that inventorship set forth in the application papers.

Petitioner has argued that answer (B) should be accepted as the most correct answer because the wording in rule 37 CFR 1.14(a)(1)(iii)(B) in comparison to the wording in answer selection (B) is very confusing. Petitioner’s arguments have been fully considered but are not persuasive. Rule 37 CFR 1.14(b)(2) indicates that status information may be supplied by the Office “if... (2) The application is referred to by its numerical identifier in a published patent document (e.g., a U.S. patent, a U.S. patent application publication, or an international application publication)....” The facts state that “Pete has an issued patent that claims priority to Application D. Assume only the last six digits of the numerical identifier are available for Application D....” Under 37 CFR 1.14(b)(2), “status information” may be supplied if the “numerical identifier” (six digit serial number and filing date) of Application D is referred to in a published patent document, e.g., in a U.S. patent. While answer (B) does not clearly state that the filing

date of Application D was published in the issued patent, it is customary for the USPTO to publish the filing date of the application to which priority has been claimed.

Accordingly, status information, including the six-digit serial number and the filing date (see 37 CFR 1.14(a)(1)(iii)(B)) may be provided to Joan. Thus, (B) is true, while morning question 8 asks for an answer which is not true. Petitioner concedes that (E) is not true because 37 CFR 1.14(c)(2) provides that since a redacted copy of the application was used for the patent application publication, the copy of the specification, drawings, and papers may be limited to a redacted copy. Accordingly, (E) is the most correct answer.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 17 reads as follows:

The following facts apply to Questions 16 and 17.

Claims 1 and 2, fully disclosed and supported in the specification of a patent application having an effective filing date of March 15, 2000, for sole inventor Ted, state the following:

Claim 1. An apparatus intended to be used for aerating water in a fish tank, comprising:

- (i) an oxygen source connected to a tube, and
- (ii) a valve connected to the tube.

Claim 2. An apparatus as in claim 1, further comprising an oxygen sensor connected to the valve.

17. Which of the following, if relied on by an examiner in a rejection of claim 2, can be a statutory bar under 35 U.S.C. § 102 of claim 2?

- (A) A U.S. patent to John, issued February 2, 1999, that discloses and claims an apparatus intended to be used for aerating ice cream, having an oxygen source

- connected to a tube, a valve connected to the tube, and a battery coupled to the oxygen source.
- (B) A U.S. patent to John, issued April 6, 1999, that discloses and claims an apparatus intended to be used for aerating water in a fish tank, having an oxygen source connected to a tube, a valve connected to the tube, and an oxygen sensor connected to the tube.
 - (C) A U.S. patent to Ned, issued February 9, 1999, that discloses, but does not claim, an apparatus intended to be used for aerating ice cream, having an oxygen source connected to a tube, a valve connected to the tube, an oxygen sensor connected to the valve, and a battery coupled to the oxygen source.
 - (D) A foreign patent to Ted issued April 12, 2000, on an application filed on March 12, 1997. The foreign patent discloses and claims an apparatus intended to be used for aerating water in a fish tank, having an oxygen source connected to a tube, a valve connected to the tube, and an oxygen sensor connected to the tube.
 - (E) None of the above.

The model answer is selection (C).

17. ANSWER: (C) is the correct answer. 35 U.S.C. § 102(b). MPEP § 2111.02 provides that the preamble generally is not accorded patentable weight where it merely recites the intended use of a structure. (A) is incorrect because it does not disclose an oxygen sensor. (B) is incorrect because the patent is not more than one year prior to the date of the Ted's application. (D) is incorrect because the Japanese patent application issued after the date of Ted's application. 35 U.S.C. § 102(d). (E) is incorrect because (C) is correct.

Petitioner has argued that answer (E) is the most correct answer because in answer (C), the patent to Ned can not be a statutory bar under 35 U.S.C. § 102 of claim 2 because the patent to Ned discloses an apparatus intended to be used for aerating ice cream, rather than an apparatus intended to be used for aerating water in a fish tank. Petitioner's arguments have been fully considered but are not persuasive. As provided in MPEP 2111.03, if the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the

claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). Accordingly, there is at least a possible contingency that the patent to Ned in answer (C) is a statutory bar under 35 U.S.C. § 102(b), and answer (C) is the most correct answer.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 18 reads as follows:

18. Which of the following is in accord with proper USPTO practice and procedure?
- (A) Satisfaction of the enablement requirement of the first paragraph of 35 U.S.C. § 112 by the disclosure in a specification also satisfies the written description requirement of the second paragraph of 35 U.S.C. § 112
 - (B) A claim to a process consisting solely of mathematical operations, *i.e.*, converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a process eligible for patent protection.
 - (C) A claim for a machine can encompass only one machine, such as a single computer, for performing the underlying process.
 - (D) A claim that recites nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, *per se*, and as such are statutory natural phenomena.
 - (E) A composition of matter is a single substance, as opposed to two or more substances, whether it be a gas, fluid, or solid.

The model answer is selection (B).

18. ANSWER: The most correct answer is (B). MPEP § 2106 (IV)(B)(2)(b)(ii) (Computer Related Process ...), "If the 'acts' of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. Thus, a claim to a process consisting solely of mathematical operations, *i.e.*, converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a statutory process." (A) is not correct. MPEP § 2106 (V)(B)(1), and see *In re Barker*, 559

F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), cert. denied, *Barker v. Parker*, 434 U.S. 1064 (1978) (a specification may be sufficient to enable one skilled in the art to make and use the invention, but still fail to comply with the written description requirement). See also *In re DiLeone*, 436 F.2d 1404, 1405, 168 USPQ 592, 593 (CCPA 1971). Also, the written description requirement is in the first paragraph, not the second paragraph, of 35 U.S.C. § 112. (C) is not correct. MPEP § 2106 (IV)(B)(2)(a) (Statutory Product Claims). (D) is not correct. MPEP § 2106 (IV)(B)(1)(c) (Natural Phenomena Such As Electricity or Magnetism), and see *O'Reilly v. Morse*, 56 U.S. (15 How.) at 112 - 114. (E) is incorrect. MPEP § 2106 (IV)(B)(2) (Statutory Subject Matter), and see *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193, 197 (1980); and *Shell Development Co. v. Watson*, 149 F. Supp. 279, 280, 113 USPQ 265, 266 (D.D.C. 1957), *aff'd per curiam*, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958).

Petitioner's arguments have been fully considered but are not persuasive.

Petitioner has argued that he could not find the quote the PTO used to back up choice (B) within MPEP § 2106. Answer (B) is the most correct answer because, as provided in MPEP § 2106 (IV)(B)(2)(b)(ii), "If the 'acts' of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter." See also *In re Schrader*, 22 F. 3d 290 at 294-95, 30 USPQ2d 1445 at 1458-59 (Fed. Cir. 1994). As further provided in MPEP § 2106 (IV)(B)(1): "Thus, a claim to a process consisting solely of mathematical operations, i.e., converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a statutory process." Petitioner argues that answer (D) should be accepted as the most correct answer. Answer (D) is not the most correct answer because, as provided in MPEP § 2106(IV)(B)(1)(c), "Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, *per*

se, and as such are nonstatutory natural phenomena. *O'Reilly v. Mose*, 56 U.S. (15 How.) 62, 112-14 (1853).”

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 27 reads as follows:

27. Mary, a legally competent adult inventor, filed provisional application A on January 3, 2000, a nonprovisional application B one year later on January 3, 2001, and nonprovisional application C on February 28, 2001. Nonprovisional application B was abandoned when nonprovisional application C was filed. The provisional application and both nonprovisional patent applications were in Mary’s name only, but a declaration has not yet been filed. Mary is living on a remote island in the middle of the Arctic Ocean where the only communication is in the summer months. Sam, the father of Mary, has been authorized by Mary to sign Mary’s name to the § 1.63 declaration and also Sam’s name. Sam, unbeknownst to Mary, also wants access to all three application files at the USPTO before he files the declaration to make certain Mary has properly described her invention. Sam acknowledges he is not an inventor but insists he must sign as an inventor so that he may act on behalf of Mary. Which of the following is not in accordance with proper USPTO procedure in relation to applications filed on or after January 1, 2001?

- (A) Sam may not add his name as an inventor since a patent is applied for only in the name or names of the actual inventor or inventors.
- (B) Since no declaration was filed during the pendency of application B, Sam may not see the Application papers for application B since he has not been authorized by Mary to see the application A and Sam is not an inventor.
- (C) Sam is not entitled to access to the provisional application A since he has not been authorized by Mary to see the application A and Sam is not an inventor.
- (D) Sam is precluded from access to the Application B since his name does not appear on the application papers and Sam is not an inventor.
- (E) Sam may sign Mary’s name to the declaration since he was authorized by Mary to do so.

The model answer is selection (E).

27. ANSWER: (E) is incorrect since an oath or declaration must be provided in accordance with 37 CFR 1.64. In 37 CFR 1.64(a) the use of word “made” implies signing or executing and is derived from §1.64. See 37 CFR 1.41(c). (A) contains the elements of

37 CFR 1.41(a). As to (B) the inventorship of a nonprovisional application is that inventorship set forth in the oath or declaration as prescribe by 37 CFR 1.63, except as provided for in 37 CFR§ 1.53(d)(4) and 1.63(d). If an oath or declaration as prescribed by § 1.63 is not filed during the pendency of a nonprovisional application, the inventorship is that inventorship set forth in the applications papers filed pursuant to § 1.53(b), unless applicant files a paper, including the processing fee set forth in § 1.17(I), supplying or changing the name or names of the inventor or inventors. Mary has not authorized Sam to inspect application B. Statement (C) is in accordance with 37 CFR 1.41(a)(2). Mary has not given Sam power to inspect the provisional application. (D) is in accordance with 37 CFR 1.41(a)(3). Mary did not authorized Sam to inspect the provisional application.

Petitioner's arguments have been fully considered but are not persuasive.

Petitioner has argued that answer (E) is not the most correct answer. Petitioner argues that Sam may sign Mary's name to the declaration because Sam has power of attorney for Mary and can sign on behalf of Mary. As provided in MPEP 409.03(b), an inventor may not authorize another individual to act as his or her agent to sign the application oath or declaration on his or her behalf. As provided in *In re Striker*, 182 USPQ 507 (Comm'r Pat. 1973), in order for another individual to have "sufficient proprietary interest" as set forth in 35 U.S.C. 118 (and 37 CFR 1.47(b)), that individual must have such an interest as to be able to participate in the grant of a patent issued on the basis of an application filed pursuant to 35 U.S.C. 118 (and 37 CFR 1.47(b)). Examples of such a person are an exclusive licensee and a trustee in bankruptcy. Sam does not have sufficient proprietary interest in the matter to justify action under 35 U.S.C. 118 and 37 CFR 1.47(b).

Petitioner also argues that answer (B) is the most correct answer because Sam has a power of attorney, may sign on behalf of Mary, and therefore would be able to see the application papers. The facts do not provide that there is a power of attorney to Sam.

While it is true that Sam could provide Mary with a power to inspect the application

under 37 CFR 1.14(d), the facts do not state that he has done so. Accordingly, answer (B) is not correct and the most correct answer is (D).

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 33 reads as follows:

The following facts pertain to questions 33 and 34.

Applicant Sonny filed a patent application having an effective U.S. filing date of February 15, 2000. The application fully discloses and claims the following:

- Claim 1. An apparatus for converting solar energy into electrical energy comprising:
- (i) a metallic parabolic reflector;
 - (ii) a steam engine having a boiler located at the focal point of the metallic parabolic reflector; and
 - (iii) an electrical generator coupled to the steam engine.

In a non-final Office action dated March 15, 2001, the examiner rejects claim 1 under 35 U.S.C. § 102(d) as anticipated by a patent granted in a foreign country to Applicant Sonny ("Foreign patent"). The Foreign patent was filed February 1, 1999, and was patented and published on January 17, 2000. The examiner's rejection points out that the invention disclosed in the Foreign patent is a glass lens with a steam engine having a boiler at the focal point of the glass lens, and an electrical generator coupled to the steam engine. The rejection states that the examiner takes official notice that it was well known by those of ordinary skill in the art of solar energy devices, prior to Applicant Sonny's invention, to use either a lens or a parabolic reflector to focus solar rays.

33. Sonny informs you that you should not narrow the scope of the claims unless absolutely necessary to overcome the rejection. Which of the following, in reply to the Office action dated March 15, 2001, is best?

- (A) Traverse the rejection arguing that the examiner's use of the Foreign patent is improper because an applicant cannot be barred by a foreign patent issued to the same applicant.
- (B) Amend claim 1 to further include a feature that is disclosed only in the U.S. application, and point out that the newly added feature distinguishes Sonny's invention over the invention in the Foreign patent.

- (C) Traverse the rejection arguing that the examiner does not create a *prima facie* case of obviousness because the examiner does not show why one of ordinary skill in the art of solar energy devices would be motivated to modify the Foreign patent.
- (D) Traverse the rejection arguing that the examiner's rejection under 35 U.S.C. § 102(d) was improper because claim 1 is not anticipated by the Foreign patent.
- (E) Traverse the rejection arguing that it was not well known to use either a lens or a parabolic reflector to focus solar rays, and submit an affidavit under 37 CFR 1.132.

The model answer is selection (D).

33. ANSWER: (D) is the correct answer. MPEP § 706.02 points out the distinction between rejections based on 35 U.S.C. §§ 102 and 103. For anticipation under 35 U.S.C. § 102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. (A), (B), (C), and (E) are each incorrect because each response does not address the lack of anticipation by the Foreign patent. (A) is further incorrect because an applicant can be barred under 35 U.S.C. § 102(d). (B) is further incorrect because the facts do not present the necessity of such an amendment. (C) is further incorrect because a *prima facie* case of obviousness is not necessary in a rejection under 35 U.S.C. § 102.

Petitioner has argued that answer (C) is best because it responds to any potential 103 rejection, and because it implicitly responds to the 102 rejection. Petitioner's arguments have been fully considered but are not persuasive. As stated in the model answer, a *prima facie* case of obviousness is not necessary in a rejection under 35 U.S.C. § 102. As set forth in 37 CFR 1.111(b), the applicant must point out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. Since the ground of rejection is anticipation under 35 U.S.C. § 102(d), anticipation under 35 U.S.C. 102(d) must be addressed in the reply. A discussion of obviousness under 35 U.S.C. § 103 is not necessary since no rejection under 35 U.S.C. § 103 was applied. Accordingly, (D) is the best answer.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

ORDER

For the reasons given above, no additional points have been added to petitioner's score on the Examination. Therefore, petitioner's score is 69. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'R. Spar', is positioned above the printed name of the Director.

Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy